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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,783	10/27/2000	Susan McConnell	59.0450	6675

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MEDTRONIC MINIMED INC.  
18000 DEVONSHIRE STREET  
NORTHRIDGE, CA 91325-1219

EXAMINER
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RODRIGUEZ, CRIS LOIREN

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/698,783	MCCONNELL ET AL.
	Examiner	Art Unit
	Cris L. Rodriguez	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 01 July 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-24 and 34-36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17, 20-24 and 34-36 is/are rejected.

7) Claim(s) 18 and 19 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 27 October 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4.5</u> .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 1-24, and 34-36 in Paper No. 7 is acknowledged.

### *Drawings*

2. Figure s 1-3b should be designated by a legend such as –Prior Art– because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The disclosure is objected to because of the following informalities: on page 17 line 7 does not include the serial number. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2 is indefinite because it is not clear what applicant is trying to say.
- Claim 21-24, “a linear actuation member” lacks proper antecedent basis since initial recitation in claim 20 is couched in functional language.

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3763

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 2, 4-9, 20, 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Butcher et al (US 6,004,300).

Butcher discloses a syringe piston having a reservoir (not shown), and a piston having a first member 10, and a second member 4 as claimed.

8. Claims 1-5, 7-10, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Namey, Jr. (US 5,902,276).

Namey discloses a syringe plunger having a reservoir (fig. 1), and a piston having a first member 32, and a second member 30 as claimed.

#### *Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-5, 7-11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser et al (US 5,919,167) in view of Namey Jr.

Mulhauser discloses an apparatus having a reservoir 26, and a plunger 28,108 having a first member 108, and a second member 28. However, Mulhauser fails to disclose the material and their stiffness that the first and second members are made.

Namey teaches a plunger where the first and second members are made of different materials and have different stiffness. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made Mulhauser's plunger with Namey's plunger materials. Doing so would have improved the hardness and the sealing characteristics of the plunger.

11. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser et al in view of Namey, Jr., and further in view of Stevens et al (US 5,735,825).

Mulhauser/Namey teaches a first chamber at 31, and a second chamber between references numerals 31 to 30. However, Mulhauser/Namey fails to disclose the second chamber having a generally cylindrical-shaped second wall with a radius greater than that of the generally cylindrical-shaped first wall, and a ledge extending from the generally cylindrical-shaped first wall to the generally cylindrical-shaped second wall.

Stevens teaches a plunger tip 32 and a sealing cap 34, where the sealing cap has a second chamber having a generally cylindrical-shaped second wall with a radius greater than that of the generally cylindrical-shaped first wall, and a ledge extending from the generally cylindrical-shaped first wall to the generally cylindrical-shaped second wall. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to modify Mulhauser/Namey's second chamber dimensions with the ones shown by Stevens. Doing so would have improved the sealing of the plunger.

***Allowable Subject Matter***

12. Claims 21-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Liao, Cane', Sudo et al, Trull, Kakimi et al, Pagay et al, and Hitchins et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

September 13, 2002

  
Cris L. Rodriguez  
Examiner  
Art Unit 3763

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700